

**REMARKS**

Claims 1-12 are pending in this application. By this Amendment, claims 1, 9 and 10 are amended to further distinguish from McMurtry (U.S. Patent Application Publication No. 2006/0037208). Claim 12 is amended to address antecedent basis issues arising from the amendments to claim 10. Support for the amendments to claims 1, 9 and 10 can be found throughout the specification, for example at page 5, line 17 to page 6, line 16. No new matter is added.

Entry of the amendments is proper under 37 CFR §1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration as the amendments amplify issues previously discussed throughout prosecution; and (c) place the application in better form for appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the final rejection. Entry of the amendments is thus respectfully requested.

In view of the foregoing amendments and the following remarks, reconsideration and allowance of claims 1-12 are respectfully requested.

**Interview**

The courtesies extended to Applicant's representative by Examiner Bhat at the interview held June 24, 2009, are appreciated. The reasons presented at the interview as warranting favorable action are incorporated into the remarks below and constitute Applicant's record of the interview.

**Common Ownership Of McMurtry**

At the time of the present invention, McMurtry and the present invention were commonly owned by Renishaw Plc. Thus, McMurtry is only available as art under 35 U.S.C.

§102(e). Thus, because McMurtry is only available under 35 U.S.C. §102(e), the Patent Office cannot rely upon McMurtry for a 35 U.S.C. §103(a) obviousness rejection.

In addition, a certified copy of the foreign priority document (GB 0325803.5), filed November 5, 2003, was provided to the Patent Office by the International Bureau. The foreign priority documents support the present claims, thereby antedating the 35 U.S.C. §102(a) date of McMurtry PCT (PCT/GB03/03738), which published on March 11, 2004.

**35 U.S.C. §102(e) Rejection**

Claims 1-12 were rejected under 35 U.S.C. §102(e) as allegedly being anticipated by McMurtry. Applicant respectfully traverses this rejection.

Claim 1 requires, among other features, (1) using data from the scan to establish orientation of a plane of the sample holder and thereby establish any misalignment or non-colinearity of the sample holder with respect to the rotatable or longitudinal axis; and (2) interpreting data from the scan using the orientation of the sample holder in order to correct the data for any misalignment or non-colinearity. By establishing the orientation of the sample holder in this manner, the sources of error due to any misalignment or a non-colinear sample holder are removed (see page 5, line 17 to page 6, line 2, of the specification). As agreed during the interview, McMurtry does not describe at least these features of claim 1 or the benefits associated therewith.

McMurtry does not describe using data from the scan to establish orientation of a plane of the sample holder and thereby establishing any misalignment or non-colinearity of the sample holder with respect to the rotatable or longitudinal axis. The Patent Office alleges that McMurtry, at paragraph [0032], describes establishing the orientation of a plane of the sample holder. McMurtry describes that before starting the scan, the relative positions of the probe and the object are established in the z-direction. The relative positions of the probe and the object are used to determine when to stop the scan (see paragraph [0032] of McMurtry).

However, as agreed during the interview McMurtry does not describe using data from the scan to establish orientation of a plane of the sample holder and thereby establish any misalignment or non-colinearity of the sample holder.

Further, McMurtry describes that the object 27 should be aligned on the center of rotation with a reasonable degree of accuracy. McMurtry describes that a certain amount of misalignment will not affect the accuracy of the results, and that an object may be placed near the circumference or edge of the sample holder. See paragraph [0038] of McMurtry. Thus, as further agreed during the interview, McMurtry does not describe interpreting data from the scan using the orientation of the sample holder in order to correct the data for any misalignment or non-colinearity.

The Patent Office alleges that paragraph [0042] of McMurtry describes establishing the orientation of a plane of the sample holder. However, McMurtry describes that data points once stored are analyzed and compared with previous data within the set to determine if certain criteria are met. However, McMurtry is not establishing the orientation of a plane of the sample holder.

The orientation McMurtry refers to is a plurality of longitudinal splines 31, as shown in Fig. 4 of McMurtry. McMurtry is analyzing the data to enable a determination of when to stop the scan by converting coordinates of the data into a radial distance from the origin, and that changes in the distance reading are used to set the criterion for whether the end of a scan has been reached. See paragraphs [0041]-[0042] and [0048] of McMurtry. McMurtry does not describe using data from the scan to establish orientation of a plane of the sample holder and thereby establish any misalignment or non-colinearity of the sample holder, as required by claim 1.

Claims 9 and 10 also require, similar to claim 1, performing a datum scan to establish any misalignment or non-colinearity of the sample holder with respect to the rotatable or

longitudinal axis; performing a scan of a sample; and interpreting data from the scan of the sample using misalignment or non-collinearity data from the datum scan in order to correct the data for any misalignment or non-collinearity. For at least those reasons presented above with regard to claim 1, McMurtry also does not anticipate claims 9 and 10.

Claims 2-8 and 11 depend from claim 1, and claim 12 depends from claim 9. For at least their respective dependency, and for the additional features recited, McMurtry also does not anticipate claims 2-8 and 11-12.

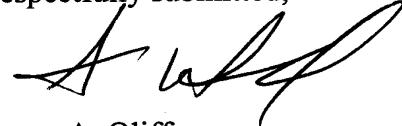
In view of the above, withdrawal of the rejection is respectfully requested.

**Concluding Remarks**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-12 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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